

**REMARKS**

The Official Action mailed September 29, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant has not received acknowledgment of the Information Disclosure Statement filed on July 24, 2002. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the Information Disclosure Statement filed on July 24, 2002.

Claims 17 and 20-26 are pending in the present application, of which claims 17 and 26 are independent. Please note, the Office Action Summary indicates that claims 1-16, 18 and 19 are withdrawn from consideration; however, claims 1-16 were canceled in a *Preliminary Amendment* filed April 2, 2002, and claims 18 and 19 were canceled in a second *Preliminary Amendment* filed July 24, 2002. Also, for the record, paragraph 2 of the Official Action should show that claims 1-16, 18 and 19 have been canceled. Claims 17 and 26 have been amended to better recite the features of the present invention and to correct a minor typographical error. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action objects to the abstract and asserts that "the form and legal phraseology often used in patent claims, such as 'figure 2', '(03-000-000) and (aura [sic] @ bcd.ef.jp on the fifth line),' should be avoided" and cites MPEP § 608.01(b) (page 2, Paper No. 10). In response, the Applicant has deleted the reference to "Figure 2" in accordance with the Examiner's suggestion. With respect to "(03-000-000)" and "aaa@bcd.ef.jp," as noted in detail below, the Applicant respectfully disagrees with the objection. MPEP § 608.01(b) states that "The form and legal phraseology often used in patent claims, such as 'means' and 'said,' should be avoided." The above-referenced allegedly objectionable phrases as used in the abstract are not examples of

the "legal phraseology" typically objected to in the abstract. Rather, "(03-000-000)" is a sample telephone number, and "aaa@bcd.ef.jp" is a sample e-mail address. These terms are necessary in order to sufficiently describe the disclosure and to assist readers in deciding whether there is a need for consulting the full patent text for details, as required by the MPEP. Reconsideration and withdrawal of the objection is respectfully requested.

Paragraph 4 of the Official Action objects to the disclosure and asserts that the disclosure "contains an embedded hyperlink and/or other form of browser-executable code" and cites MPEP § 608.01 (page 2, Paper No. 10). Although not explicitly stated, it appears that the Official Action is objecting to the use of a sample e-mail address, i.e. "aaa@bcd.ef.jp" (page 6, line 14, and Figures 2-5), and/or to the use of a sample URL, i.e. "http://somewhere.co.jp" (page 11, line 14). The Applicant respectfully disagrees with the objection. MPEP § 608.01 states the following:

Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.

The Applicant respectfully submits that the sample e-mail address, i.e. "aaa@bcd.ef.jp" and the sample URL, i.e. "http://somewhere.co.jp" are themselves part of the Applicant's invention and it may be necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph. As is clear from the sequential alphabetical representation in the sample e-mail address and the commonly used "somewhere" domain name, the above-referenced e-mail address and URL are mere samples and not actual addresses or hyperlinks. As such, the Applicant does not intend for the e-mail address or the hyperlink to be active. Therefore, the objection should be withdrawn, and it is further understood that the Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.

Paragraph 6 of the Official Action rejects claims 17, 20-23 and 26 as anticipated by U.S. Patent No. 6,151,507 to Laiho et al. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 17 and 26 have been amended to recite retrieving address information from the contents of a reception history of messages displayed on a displaying means or in a displaying step, the address information being a non-regular format destination information which was arbitrarily written in an ordinary message sentence by a communication partner. Laiho does not teach all the above-referenced features of the amended independent claims, either explicitly or inherently.

The present invention is characterized in that in a mobile communication terminal, a message sent from a communication party is received, stored and displayed, and address information is then retrieved from the reception history of the message to register the retrieved address information. The present invention is directed to using a technique of detecting and extracting a non-regular format destination information (such as an e-mail address or a telephone number), which was arbitrarily written in an ordinary message sentence by a calling party, from a string of characters in a message received by a called party.

Thus, the present invention functions to detect and extract the non-regular format destination information (such as an e-mail address or a telephone number) which was written in the mail together with the ordinary message sentences. It is explained in detail in the specification how to concretely detect and extract the non-regular destination information.

Moreover, in the present invention, it is a series of received messages from a certain time point in the past to the present time point that are to be detected, thereby it is possible for a user to designate a received message at any time point from the series of received messages and to arbitrarily extract the "destination information" of the calling party from the received designated message.

The above-referenced features of the present invention are not disclosed in Laiho, either explicitly or inherently. Although Laiho appears to teach that a user may specify that a network convert an SMS message to an electronic mail (E-mail) message (column 4, line 9+), Laiho does not teach retrieving address information from the contents of a reception history of messages displayed on a displaying means or in a displaying step, the address information being a non-regular format destination information (such as an e-mail address or a telephone number) which was arbitrarily written in an ordinary message sentence by a communication partner, either explicitly or inherently.

Since Laiho does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 8 of the Official Action rejects claims 24 and 25 as obvious based on the combination of Laiho and U.S. Patent No. 6,535,749 to Iwata et al. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

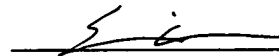
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Laiho. Iwata does not cure the deficiencies in Laiho. The Official Action relies on Iwata to allegedly teach "personal information searching means" (page 4, Paper No. 10). However, Laiho and Iwata, either alone or in combination, do not teach or suggest retrieving address information from the contents of a reception history of messages displayed on a displaying means or in a displaying step, the address information being a non-regular format destination information which was arbitrarily written in an ordinary message sentence by a communication partner. Since Laiho and Iwata do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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## REPLACEMENT ABSTRACT

A mobile communication terminal for registering information, e.g. an e-mail address or a telephone number obtained in the form of characters correctly and easily, as it is or after correcting part of such information, in a telephone directory. Two character strings corresponding to the address of the party to be called or the party with which information is communicated are present in the contents of a received mail ~~shown in Figure 2~~. One character string represents a telephone number (03-000-0000 on the third line) and the other character string represents an e-mail address (aaa @ bcd.ef.jp on the fifth line). A character string representative of these two addresses is retrieved, displayed on a display section and registered in a telephone directory by selecting the displayed address.